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10/686,846	10/16/2003	Esther A.L. Verbovszky	V15-6688	1764

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526 SUPERIOR AVENUE  
CLEVELAND, OH 44114-1400

EXAMINER
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SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/686,846

Applicant(s)

VERBOVSZKY, ESTHER A.L.

Examiner

James N Smailey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 7 is objected to because of the following informalities: The claim status identifier lists the claim as "currently amended;" however there are no underlined changes in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation, "said second portion being threadless," added by amendment to claim 1, and presented new in claim 14, is not fully enabled by the Specification as originally filed, and thus comprises new matter.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porthouse et al. US 2,269,223 in view of Robinson US 2,805,663.

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Porthouse '223 teaches a cap for a beverage bottle, having a liquid passage, first portion (10) engageable with a user's mouth, bottle clamping portion (11), disclosed in col. 2, lines 29-30 as being formed of rubber or other elastic material, stop member (17), and pull tabs (14). In col. 2, lines 29-30, Porthouse '223 teaches, "the nipple is formed of a rubber or other elastic material." Because the device is formed of rubber – one of the claimed materials from which the device is formed – it is inherently capable of being deformed by a baby's mouth.

Porthouse '223 does not teach the pull tabs extending downwardly and outwardly.

Robinson '663 teaches a handle for a beverage dispensing cap, which extends downwardly and outwardly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pull tabs of Porthouse '223, forming them to extend downwardly and outwardly, as taught by Robinson '663, because such a configuration is a mechanical equivalent capable of functioning equally well. Furthermore, the configuration taught by the Applicant does not appear to comprise an unexpected result beyond routine experimentation of a known structure. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Regarding the limitation that the limitation of claim 1 that the device stretch and then relax to clamp onto the neck of a bottle, Examiner notes the claims are drawn to a cap for a baby's beverage bottle. Therefore, the reference must only meet the claimed structural limitations in order to obviate the claims. The device of Porthouse '223, in meeting the claimed structural limitations, can inherently be used in the intended manner, i.e. be placed over the neck of a baby's beverage bottle, such that the rubber material will stretch and then relax to clamp onto the bottle. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 11 and 14, Porthouse '223 does not teach a smooth tab.

Robinson '663 teaches the pull tab being formed with a smooth surface.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pull tab of Porthouse '223, forming the grip tab smooth, as taught by Robinson '663, because such a tab is a mechanical equivalent capable of functioning equally well. Furthermore, it would be obvious to remove the grip ridges taught by Porthouse '223, motivated by the benefit of providing a surface for users who do not prefer textured tabs. Furthermore, a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

6. Claims 1-2, 4-5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson US 2,443,560 in view of Robinson US 2,805,663.

Goodson '560 teaches a cap for a beverage bottle, having a liquid passage, first portion (15) engageable with a user's mouth, bottle clamping portion (19), disclosed in col. 1, lines 2-3 as being formed of rubber, stop member (25), and pull tabs (17). In col. 1, lines 1-2, "This invention relates to nursing nipples...constructed of rubber." Because the device is formed of rubber – one of the claimed materials from which the device is formed – it is inherently capable of being deformed by a baby's mouth.

Goodson '560 does not teach the pull tabs extending downwardly and outwardly.

Robinson '663 teaches a handle for a beverage dispensing cap, which extends downwardly and outwardly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pull tabs of Goodson '560, forming them to extend downwardly and outwardly, as taught by Robinson '663, because such a configuration is a mechanical equivalent capable of functioning equally well. Furthermore, the configuration taught by the Applicant does not appear to comprise an unexpected result beyond routine experimentation of a known structure. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Regarding the limitation that the limitation of claim 1 that the device stretch and then relax to clamp onto the neck of a bottle, Examiner notes the claims are drawn to a cap for a baby's beverage

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bottle. Therefore, the reference must only meet the claimed structural limitations in order to obviate the claims. The device of Goodson '560, in meeting the claimed structural limitations, can inherently be used in the intended manner, i.e. be placed over the neck of a baby's beverage bottle, such that the rubber material will stretch and then relax to clamp onto the bottle. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 11 and 14, Goodson '560 does not teach a smooth tab.

Robinson '663 teaches the pull tab being formed with a smooth surface.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pull tab of Goodson '560, forming the grip tab smooth, as taught by Robinson '663, because such a tab is a mechanical equivalent capable of functioning equally well. Furthermore, it would be obvious to remove the grip ridges taught by Goodson '560, motivated by the benefit of providing a surface for users who do not prefer textured tabs. Furthermore, a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porthouse et al. US 2,269,223 in view of Robinson US 2,805,663, as applied above to claim 1, in further view of Heilborn US 2,388,915.

Porthouse '223 does not teach a raspberry effect.

Heilborn '915 teaches a raspberry effect on a nipple, teaching in col. 1, line 55 through col. 2, lines 1-4 the surface prevents undesirable slipping and provides the infant with a natural feeling of gripping with little effort.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Porthouse '223, providing the raspberry effect taught by Heilborn '915,

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motivated by the benefit of preventing undesirable slipping and providing the infant with a natural feeling of gripping with little effort.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson US 2,443,560 in view of Robinson US 2,805,663, as applied above to claim 1, in further view of Heilborn US 2,388,915.

Goodson '560 does not teach a raspberry effect.

Heilborn '915 teaches a raspberry effect on a nipple, teaching in col. 1, line 55 through col. 2, lines 1-4 the surface prevents undesirable slipping and provides the infant with a natural feeling of gripping with little effort.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Goodson '560, providing the raspberry effect taught by Heilborn '915, motivated by the benefit of preventing undesirable slipping and providing the infant with a natural feeling of gripping with little effort.

9. Claim 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porthouse et al. US 2,269,223 in view of Robinson US 2,805,663, as applied above to claim 1, in further view of Pancoast US 2,709,434.

Porthouse '223 does not teach a bulbous terminal end with a plurality of ribs and a frustum portion extending from the ribs.

Pancoast '434 teaches bulbous terminal end (3) with ribs (8) and (9), and a frustum (unlabeled; located below (9)), teaching the ribs serve to allow the nipple to bend.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Porthouse '223, providing it with the ribs (8) and (9) and frustum of Pancoast '434, motivated by the benefit of facilitating bending of the nipple.

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10. Claim 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson US 2,443, in view of Robinson US 2,805,663, as applied above to claim 1, in further view of Pancoast US 2,709,434.

Goodson '560 does not teach a bulbous terminal end above a plurality of ribs.

Pancoast '434 teaches bulbous terminal end (3) with ribs (8) and (9), and a frustum (unlabeled; located below (9)), teaching the ribs serve to allow the nipple to bend.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Goodson '560, providing it with the ribs (8) and (9) and frustum of Pancoast '434, motivated by the benefit of facilitating bending of the nipple.

11. Claim 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porthouse et al. US 2,269,223 in view of Velonis et al. US 3,394,018.

Porthouse '223 does not teach a bulbous terminal end above a plurality of ribs.

Velonis '018 teaches a bulbous terminal nipple end (40), with a plurality of ribs (42), teaching in col. 4, lines 19-27 the ribs allow the nipple to be freely pivoted, so that it can move without impeding the flow of liquid.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Porthouse '223, providing the bulbous terminal end and ribs as taught by Velonis '018, motivated by the benefit of allowing the nipple to pivot without impeding the flow of liquid.

12. Claim 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson US 2,443,560 in view of Velonis et al. US 3,394,018.

Goodson '560 does not teach a bulbous terminal end above a plurality of ribs.

Velonis '018 teaches a bulbous terminal nipple end (40), with a plurality of ribs (42), teaching in col. 4, lines 19-27 the ribs allow the nipple to be freely pivoted, so that it can move without impeding the flow of liquid.



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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Goodson '560, providing the bulbous terminal end and ribs as taught by Velonis '018, motivated by the benefit of allowing the nipple to pivot without impeding the flow of liquid.

13. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porthouse et al. US 2,269,223 in view of Robinson US 2,805,663 as applied above to claim 1, in further view of Klag US 5,190,174.

Porthouse '223 does not teach a bellows located below the terminal end and a frustum portion.

Klag '174 teaches a teat for a bottle, comprising a bellows (20) enabling bending and flexing of the nipple.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Porthouse '223, providing the bellows taught by Klag '174, motivated by the benefit of enabling the nipple to bend and flex.

14. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson US 2,443,560 in view of Robinson US 2,805,663 as applied above to claim 1, in further view of Klag US 5,190,174.

Goodson '560 does not teach a bellows located below the terminal end and a frustum portion.

Klag '174 teaches a teat for a bottle, comprising a bellows (20) enabling bending and flexing of the nipple.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Goodson '560, providing the bellows taught by Klag '174, motivated by the benefit of enabling the nipple to bend and flex.

15. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porthouse et al. US 2,269,223 in view of Robinson US 2,805,663 and in view of Klag US 5,190,174, as applied above to claim 7, and in further view of Condon US 2,174,361.

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Porthouse '223, as modified, does not disclose a plurality of apertures.

Condon '361, fig. 4, teaches a plurality of apertures, disclosing in col. 4, lines 8-11 the structure is designed to compare with that of the human breast nipple.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Porthouse '223, providing a plurality of apertures as taught by Condon '361, motivated by the benefit of replicating the structure of a human breast nipple.

16. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson US 2,443,560 in view of Robinson US 2,805,663 and in view of Klag US 5,190,174, as applied above to claim 7, and in further view of Condon US 2,174,361.

Goodson '560, as modified, does not disclose a plurality of apertures.

Condon '361, fig. 4, teaches a plurality of apertures, disclosing in col. 4, lines 8-11 the structure is designed to compare with that of the human breast nipple.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Goodson '560, providing a plurality of apertures as taught by Condon '361, motivated by the benefit of replicating the structure of a human breast nipple.

17. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porthouse et al. US 2,269,223 in view of Robinson US 2,805,663 and in view of Klag US 5,190,174, as applied above to claim 7, and in further view of Tupper US 2,816,548.

Porthouse '223 does not teach tapering faces separated by curved walls creating an approximately ovular cross section.

Tupper '548 teaches a nipple comprising first and second tapering faces (21) separated by curved walls (24), creating an approximately ovular cross section. The shape fits the contours and shape of the human mouth, providing an comfortable drinking spout.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Porthouse '223, forming it with tapering faces separated by curved walls

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creating an approximately ovular cross section, as taught by Tupper '548, motivated by the benefit of providing a comfortable drinking spout that fits the contours and shape of a human mouth.

18. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson US 2,443,560 in view of Robinson US 2,805,663 and in view of Klag US 5,190,174, as applied above to claim 7, and in further view of Tupper US 2,816,548.

Goodson '560 does not teach tapering faces separated by curved walls creating an approximately ovular cross section.

Tupper '548 teaches a nipple comprising first and second tapering faces (21) separated by curved walls (24), creating an approximately ovular cross section. The shape fits the contours and shape of the human mouth, providing an comfortable drinking spout.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nipple of Goodson '560, forming it with tapering faces separated by curved walls creating an approximately ovular cross section, as taught by Tupper '548, motivated by the benefit of providing a comfortable drinking spout that fits the contours and shape of a human mouth.

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (571) 272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns



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